

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
R. Sanders WILLIAMS et al.

Serial No.: 09/782,953

Filed: February 13, 2001

For: METHODS RELATING TO MUSCLE
SELECTIVE CALCINEURIN
INTERACTING PROTEIN (MCIP)

Patent No.: 7,629,308

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May 19, 2010
Date

Steven L. Highlander

**REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT IN VIEW OF WYETH**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Patentees request reconsideration of Patent Term Adjustment (PTA) under 37 C.F.R. §1.705(d). The Notice Concerning Improper Calculation of Patent Term Adjustment Based Upon USPTO Improperly Measuring Reduction Period Under 37 CFR 1.704(c)(10) dated May 18, 2010 indicates a PTA of 769 days. Applicants believe this to be an error and request the PTA to be changed to 2,046 days.

REMARKS

The patent term adjustment under 35 U.S.C. §154(b) for the above-identified patent is listed as 769 days. The determination of 769 days is in error in that pursuant to 35 U.S.C. §154(b) the Office failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 37 CFR §1.702(b) **and** failed to take certain action within the time frame specified in 37 CFR §1.702(a).

Pursuant to 37 CFR §1.703(b), Patentees are entitled to a period of patent term adjustment due to failure of the Office to issue a patent within three years after the date the corresponding application was filed under 35 U.S.C. §111(a), *i.e.*, February 13, 2004 (hereinafter "Three Year Delay"). Since the Office failed to issue the above-identified patent until December 8, 2009, Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is 3 years after the filing date of the application, *i.e.*, February 14, 2004, and ending on the date a patent is issued, *i.e.*, December 8, 2009. Accordingly, the period of patent term adjustment due to the Three Year Delay by the Office is 2,125 days. This period of adjustment is erroneously listed as 848 days on the Patent Term Adjustment Sheet available on PAIR.

Patentees agree with the Office's determination of patent term adjustment due to examination delay available under §1.702(a) as 172 days, for failure to mail an action under 35 U.S.C. §132 not later than 14 months after the actual filing date.

As set forth in 37 CFR §1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR §1.702 (hereinafter "Office

Delay") reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR §1.704 (hereinafter "Applicant Delay"). With respect to the above-referenced application, the total period of Office Delay is the sum of the period of Three Year Delay (2,125 days) and the period of Examination Delay (172 days) *to the extent these periods of delay are not overlapping*. As the period of 14 Month Delay ended on October 2, 2002, prior to the first day of the period of Three Year Delay, *i.e.*, February 14, 2004, Patentees submit that these periods are not overlapping. Accordingly, Patentees submit that the total period of Office Delay is 2,297 days, which is the sum of the period of Three Year Delay (2,125 days) and the period of Examination Delay (172 days).

To calculate the period of patent term adjustment, the total period of Office Delay is reduced by the period of Applicant Delay, which the Office correctly calculated as a period of 251 days. Accordingly, Patentees submit that the correct patent term adjustment for the above-referenced application is **2,046 days**, which is the difference between the total period of Office Delay (2,297 days) and the period of Applicant Delay (251 days).

In view of the foregoing, it is respectfully requested that this Request for Reconsideration of Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **2,046 days**.

CONCLUSION

In consideration of the events described above, Patentees believe the PTA calculation of 769 days is incorrect. As such, Applicants respectfully request reconsideration of the PTA in the following manner:

- 1) Total Office delay should be calculated as 2,297 days;
- 2) Total Applicant delay should be calculated as 251 days; and
- 3) Total PTA should be calculated as 2,046 days.

The required fee in the amount of \$200.00 in connection with the filing of this paper is being charged to a credit card through EFS-Web concurrently with this submission. The Commissioner is hereby authorized to deduct any underpayment of fees or any additional fees required under 37 C.F.R. §§ 1.16 to 1.21 in connection with the filing of this paper from Fulbright & Jaworski Deposit Account No.: 50-1212/MYOG:036US.

Respectfully submitted,



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